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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,119	11/25/2003	Michel H. Malek	036163-0103	4839

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EXAMINER	
COMSTOCK, DAVID C	
ART UNIT	**PAPER NUMBER**
3733	

MAIL DATE	DELIVERY MODE
05/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/722,119	MALEK, MICHEL H.	
	Examiner	Art Unit	
	David Comstock	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 February 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25 and 43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-25 and 43* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

In view of the cancellation of claims 26-42 and 44, by Applicant, and in view of Applicant's arguments filed 20 February 2007, the outstanding election requirement has been withdrawn without prejudice. In the event that other claims directed to other embodiments or species are later added, such claims may be subject to further election and/or restriction. With regard to the presently pending claims, and upon further consideration, Examiner maintains that this application contains claims directed to the following patentably distinct species of the stabilizing element:

I. rod

II. plate

The species are distinct because the inventions as claimed are mutually exclusive, are not obvious variants, are not disclosed as being capable of being used together, and have a materially different design and specific mode of operation. Moreover, examination of both species would be a serious burden on the examiner. Claim 2 recites a rod and claim 3 does not; claim 3 recites a plate and claim 2 does not. As claimed, the invention having a rod would not infringe on an invention utilizing a plate. A rod is not a plate and a plate is not a rod. Moreover, there is no art of record and no specific teachings showing that a plate and a rod are obvious variants or that one may be substituted for another. It is noted that a rod may be longer and may not occupy as much area as compared to a plate but may not distribute loads the same way and may not provide sufficient area for holes or other features. Rods typically attach to

pedicle screws whereas plates generally attach directly to cortical bone. Therefore, it is not clear on the record that plates and rods are obvious variants, as they would likely serve different purposes. In addition, Applicant has not disclosed, and the claims do not recite, that a plate and a rod are capable of being used together. Even if they could be used together rods and plates have a materially different design and specific mode of operation. Whereas plates occupy more area and distribute loads throughout a wide but narrow area, rods are generally elongate and narrow and distribute loads through a small centered area. The formulas to design rods and plates are different, their mechanical properties are different and the way in which they are attached and used are different. Finally, it is noted that spinal rods and the like are generally classified in class 606/61 while plates and the like are generally classified in class 606/69. The searches are exclusive. In addition, a complete search involves more than just class searches. Different text queries produce significant additional patents to consider, both within the art and outside of the art but disclosing relevant structure. The additional time and consideration to formulate the queries and especially to properly consider their results is indeed a significant and serious burden on the examiner's limited time.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 21 are generic. Therefore, if a generic claim is later found to contain allowable subject matter, dependent claims directed to the non-elected species will be subject to rejoinder and allowance.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions

unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Comstock

EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER